

REMARKS

This Amendment is being filed in response to the Office Action mailed September 17, 2007, which has been reviewed and carefully considered. Reconsideration and allowance of the present application in view of the amendments made above and the remarks to follow are respectfully requested.

By means of the present amendment, the current Abstract has been deleted and substituted with the enclosed New Abstract which better conforms to U.S. practice.

By means of the present amendment, claims 1-9 have been amended for non-statutory reasons, such as for better form including beginning the dependent claims with 'The' instead of 'A', and changing "characterized in that" to --wherein--. Claims 1-9 were not amended in order to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents.

In the Office Action, the Examiner rejected claims 1-10 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending Application No. 10/117,852. This rejection is respectfully traversed since the

recitation of independent claim1, namely, $\text{Ga}_x\text{In}_y\text{Sb}_z$ and $70 \leq z \leq 95$ and $x + y + z = 100$, is nowhere disclosed or suggested in the claims of copending Application No. 10/117,852. However, it is respectfully submitted that Applicants will consider filing a terminal disclaimer, if necessary in view of any allowable claims, upon indication that the present application is otherwise allowable or includes allowable claims.

In the Office Action, claims 1-5 are rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,072,423 (Koshino). Claims 1-10 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2002/0160305 (Horie). Claims 1-10 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent Application Publication No. 2002/0059711 (Lankhorst). Claims 6-10 are rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Koshino in view of U.S. Patent No. 5,914,214 (Ohta). It is respectfully submitted that claims 1-10 are patentable Koshino, Horie, Lankhorst and Ohta for at least the following reasons.

Koshino is directed to a memory medium having an alloy of $\text{Ga}_{40}\text{Sb}_{60}$. On page 22, lines 49 and 52, Koshino discloses a memory

film comprising 5 to 50 atom % of Ga and 50 to 95 atom % of Sb; or 15 to 35 atom % of Ga and 65 to 85 atom % of Sb.

It is respectfully submitted that a disclosure of a range from 50-95% or 65-85% Sb is so broad that it does not teach or suggest the narrower and more specific range of 70-95% or 77-91% of Sb, as recited in claims 1 and 2, respectively. This is a situation analogous to the obviousness of a species when the prior art broadly discloses a genus. (See also *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); and MPEP §2144.05 and §2144.08.

It is well known that in disclosing a genus, there is no disclosure of all species. (See *Corning Glass Works v. Sumitomo Electric U.S.A* 868 F.2d. 1251, 9 USPQ2d 1962 (Fed Cir. 1989)). Large genus does not render a claim to three species obvious, as noted in *In re Baird*, *Supra*, where it is recited that a "disclosure of millions of compounds does not render obvious a claim to three compounds." Further, in *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (C.C.P.A. 1958), the CCPA reversed the Board's opinion noting:

To rely on an equivalence known only to the applicant to establish obviousness is to assume that his disclosure is a part of the prior art. The mere

statement of this proposition reveals its fallaciousness...To sum it all up, actual equivalence is not enough to justify refusal of a patent on one member of a group when another member is in the prior art. The equivalence must be disclosed in the prior art or be obvious within the terms of Section 103.

Assuming arguendo, that Koshino discloses or suggested the range recited in claims 1-2, it respectfully submitted that Koshino does not teach or suggest a recording layer having an alloy of Sb that includes both Ga and In where the atomic percentages of Sb is between 70-95%, as recited in independent claim 1. Further, Koshino is completely silent about any directly overwriting any medium a linear velocity of more than 10 m/s as recited in independent claim 1.

Horie discloses a recording layer that includes tellurium (Te). In stark contrast, independent claim recites that the "alloy does not include Te."

Lankhorst discloses a recording layer having an alloy of Sb where the highest percentage of Sb is 54%. Lankhorst does not teach or suggest a recording layer having an alloy of Sb that includes both Ga and In where the atomic percentages of Sb is between 70-95%, as recited in independent claim 1.

In is respectfully submitted Koshino, Horie, Lankhorst and combination thereof, do not teach or suggest the present invention as recited in independent claim 1, which, amongst other patentable elements, recites (illustrative emphasis provided):

wherein the alloy does not include Te and is of a composition in atomic percentages defined by the formula:

$Ga_xIn_ySb_z$ and $70 \leq z \leq 95$ and $x + y + z = 100$; and x , y , and z are not equal to zero, so that the medium may be directly overwritten a linear velocity of more than 10 m/s.

Ohta is cited to allegedly show other features and does not remedy the deficiencies in Koshino, Horie and Lankhorst.

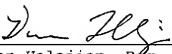
Accordingly, it is respectfully submitted that independent claim 1 is allowable, and allowance thereof is respectfully requested. In addition, it is respectfully submitted that claims 2-11 should also be allowed at least based on their dependence from amended independent claim 1.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to

submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

In view of the above, it is respectfully submitted that the present application is in condition for allowance, and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

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Enclosure: New Abstract

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